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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,795	11/23/2001	George Jackowski	2132.105	5610
21917	7590	10/21/2003	EXAMINER	
MCHALE & SLAVIN, P.A. 2855 PGA BLVD PALM BEACH GARDENS, FL 33410			DAVIS, DEBORAH A	
			ART UNIT	PAPER NUMBER
			1641	

DATE MAILED: 10/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/991,795

Applicant(s)

JACKOWSKI ET AL.

Examiner

Deborah A Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 39-46 is/are pending in the application.
- 4a) Of the above claim(s) 39-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicant's election without traverse of Group I, in Paper No. 8 is acknowledged. Applicant's cancellation of non-elected claims 2-38 and the addition of new claims 39-46 are acknowledged, but new claims require further restriction because they are independent and distinct inventions:

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1 drawn to a biopolymer marker, comprising SEQ ID NO: 1, classified in class 530, subclass 300.
- II. Claims 39-43, drawn to a method of diagnosing insulin resistance, classified in class 424, subclass 93.1.
- III. Claims 44-46, drawn to a diagnostic assay kit, classified in class 436, subclass 808.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product of group I can be practiced with the diagnostic assay kit of group III.

4. Inventions I and III are unrelated products. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case inventions I and II have different modes of operation.

Invention I is drawn to a biopolymer marker comprising SEQ ID NO: 1; Invention III is drawn to a kit comprising components various samples and a solid support and an antibody. Therefore, each disclosed patentably distinct product is considered a separate invention.

5. Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product of group III can be practiced with the Biopolymer marker of group I.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. Please note that classifications in the restriction are illustrative only and do not represent all the classes and subclasses which must be searched for each invention; nor is the search limited to

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issued US patents, but rather includes foreign patents and applications as well as literature searches, therefore restriction for examination purposes as indicated proper.

7. During a telephone conversation with Ferris Lander on 10-17-03 a provisional election was made without traverse to prosecute the invention of group I, claim 1.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 39-46 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is not supported by either specific, substantial or asserted utility or a well established utility.

The claimed biopolymer marker peptide is not supported by either a specific and substantial asserted utility or a well established utility because the specification fails to assert any utility for the peptide. The specification as filed does not disclose or provide any evidence that points to an activity for the peptide. Additionally, there is not art of record that discloses or suggests any activity for the claimed peptide such that any utility would be established for the peptide. While the specification discloses conventional protein isolation techniques, it does not include any working examples.

Therefore, it is reasonable to conclude that the utility would not be credible based on the

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evidence of record. A well established utility is a specific, substantial and credible utility which is well known, immediately apparent or implied by the specification's disclosure of the properties of a material, alone or taken with the knowledge of one skilled in the art. A well established utility is not any utility that one can dream up for an invention or a nonspecific utility that would obviously apply to virtually every member of a very general class of materials, such as protein or DNA.

### ***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific or asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to **use** the claimed invention so that it would operate as intended without undue experimentation.

### ***Conclusion***

11. Claim 1 is free of the prior art.

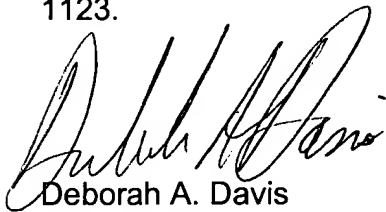
12. No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah A Davis whose telephone number is (703) 308-4427. The examiner can normally be reached on 8-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (703) 305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1123.



Deborah A. Davis  
CM1, 7D16  
October 16, 2003



LONG V. LE  
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10/21/03